

**Amendment and Response**  
Applicant: Alan C. Berkema et al.  
Serial No.: 09/897,656  
Filed: June 29, 2001  
Docket No.: 10016784-

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**SEP 28 2006**

**Title: PORTABLE WIRELESS DEVICE AND SOFTWARE FOR PRINTING BY REFERENCE**

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### **REMARKS**

The following Remarks are made in response to the Non-Final Office Action mailed June 28, 2006, in which claims 4, 5, 9-12, 15, 18-20, 22, 32-34, and 37-39 were rejected.

With this Amendment, claims 40-45 have been added, and claims 4, 5, 9-12, 15, 18-20, 22, 32-34, and 37 have been amended to clarify Applicant's invention. Claims 4-5, 9-12, 15, 18-20, 22, 32-34, and 37-45, therefore, remain pending in the application and are presented for reconsideration and allowance.

### **Double Patenting**

Claims 4, 5, 15, 18-20, 22, and 33 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 6 and 31 of co-pending Application No. 09/897,697.

Concurrently with this Amendment, a terminal disclaimer in compliance with 37 CFR 1.321(c) has been filed to overcome the non-statutory double patenting rejection based on Application Serial No. 09/897,697. Applicant submits that the filing of this terminal disclaimer is to obviate the rejection based on non-statutory double patenting and is not an admission of the propriety of the rejection.

In view of the above, Applicant submits that the non-statutory double patenting rejection of claims 4, 5, 15, 18-20, 22, and 33 has been overcome. Applicant, therefore, respectfully requests that the rejection of claims 4, 5, 15, 18-20, 22, and 33 under the judicially created doctrine of obviousness-type double patenting be reconsidered and withdrawn, and that claims 4, 5, 15, 18-20, 22, and 33 be allowed.

### **Claim Rejections under 35 U.S.C. § 112**

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. More specifically, the Examiner contends that "the responsive signal" in claim 15 lacks antecedent basis.

With this Amendment, claim 15 has been amended to provide proper antecedent basis for "the responsive signal." Applicant, therefore, respectfully requests that the rejection of

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claim 15 under 35 U.S.C. 112, second paragraph, be reconsidered and withdrawn, and that claim 15 be allowed.

**Claim Rejections under 35 U.S.C. § 102**

Claims 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Larsson et al. WO 01/42894.

With this Amendment, independent claim 37 has been amended to clarify that the portable wireless device includes "a first communication interface adapted to enable first communication between the portable wireless device and a content provider, and second communication between the portable wireless device and a print service, wherein the print service is distinct from the content provider, and the second communication is distinct from the first communication."

With respect to the Larsson et al. reference, Applicant submits this reference does not teach or suggest a portable wireless device as claimed in independent claim 37, wherein a first communication interface is adapted to enable first communication between the portable wireless device and a content provider, and second communication between the portable wireless device and a print service, with the print service being distinct from the content provider, and the second communication being distinct from the first communication.

In view of the above, Applicant submits that independent claim 37 is patentably distinct from the Larsson et al. reference and, therefore, is in a condition for allowance. Furthermore, as dependent claims 38-39 further define patentably distinct claim 37, Applicant submits that these dependent claims are also in a condition for allowance. Applicant, therefore, respectfully requests that the rejection of claims 37-39 under 35 U.S.C. 102(b) be reconsidered and withdrawn, and that claims 37-39 be allowed.

**Claim Rejections under 35 U.S.C. § 103**

Claims 4, 5, 9-12, 15, 18-20, 22, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US Patent No. 6,385,728 in view of Larsson et al. WO 01/42894.

With this Amendment, independent claim 4 has been amended to clarify that the computer readable code causes the computer to "wirelessly communicate a discovery signal

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for locating one or more print devices," "receive a responsive signal from a print device in response to the discovery signal, the responsive signal identifying a physical location of the print device," and "wirelessly communicate a reference to the print device."

With this Amendment, independent claim 5 has been amended to clarify that the computer readable code causes the computer to "wirelessly communicate a reference to a print device, the reference identifying a location at which a print content of a content provider is located on a network and a location of a print service," "wherein the reference causes the print device to retrieve the print content of the content provider from the network by causing the print device to supply the reference to the print service," and "wherein the print service is distinct from the content provider, and wherein the print service is adapted to retrieve the print content of the content provider from the network and further adapted to format the retrieved print content for printing."

With this Amendment, independent claim 9 has been amended to clarify that the computer readable code causes the computer to "store a reference in a memory of the computer, the reference identifying a location at which a print content is located on a network," "retrieve the reference from the memory of the computer," and "wirelessly communicate the reference to a print device, wherein the reference causes the print device to retrieve the print content from the network and to print the print content."

With this Amendment, independent claim 15 has been amended to clarify that the computer readable code causes the computer to "wirelessly communicate a discovery signal to the print device, and receive a responsive signal transmitted by the print device," "wherein the responsive signal identifies the print device," and "wherein the responsive signal further identifies one or more of the print capabilities of the print device, the one or more of the print capabilities identifying a capability of the print device to print the print content."

With this Amendment, independent claim 18 has been amended to clarify that the computer readable code causes the computer to "wirelessly communicate a reference to a print device, the reference identifying a location at which a print content of a content provider is located on a network," and causes the computer to "add information to the reference before wirelessly communicating the reference to the print device," "wherein the information added to the reference comprises a locator, the locator identifying a location of a print service," and

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"wherein the print service is distinct from the content provider, and wherein the print service is adapted to format the print content for printing."

With this Amendment, independent claim 19 has been amended to clarify that the computer readable code causes the computer to "wirelessly communicate a discovery signal for locating one or more print devices," "receive a responsive signal from a print device in response to the discovery signal, the responsive signal identifying a physical location of the print device," and "wirelessly communicate a reference to the print device."

With this Amendment, independent claim 20 has been amended to clarify that the computer readable code causes the computer to "store a reference in a memory of the computer, the reference identifying a location at which a print content is located on a network," "retrieve the reference from the memory of the computer," and "wirelessly communicate the reference to a print device."

With this Amendment, independent claim 22 has been amended to clarify that the computer readable code causes the computer to "after wirelessly communicating the reference to the print device, communicate a request for status information to the print device," and "in response to the request, receive status information from the print device, the status information including at least one of status of retrieval of the print content and status of printing the print content."

With this Amendment, independent claim 32 has been amended to clarify that "the processor is further adapted to cause the communication interface to transmit a discovery signal for locating one or more print devices, and adapted to wait for a response to the discovery signal from the print device before communicating the reference to the print device, wherein the response includes at least one of a physical location of the print device and a capability of the print device to print the print content."

With respect to the DeBry and Larsson et al. references, Applicant submits these references, individually or in combination, do not teach or suggest a computer program product comprising a computer readable code as claimed in independent claim 4, do not teach or suggest a computer program product comprising a computer readable code as claimed in independent claim 5, do not teach or suggest a computer program product comprising a computer readable code as claimed in independent claim 9, do not teach or suggest a computer program product comprising a computer readable code as claimed in independent

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claim 15, do not teach or suggest a computer program product comprising a computer readable code as claimed in independent claim 18, do not teach or suggest a computer program product comprising a computer readable code as claimed in independent claim 19, do not teach or suggest a computer program product comprising a computer readable code as claimed in independent claim 20, do not teach or suggest a computer program product comprising a computer readable code as claimed in independent claim 22, and do not teach or suggest a portable wireless device as claimed in independent claim 32.

In view of the above, Applicant submits that independent claims 4, 5, 9, 15, 18, 19, 20, 22, and 32 are each patentably distinct from the DeBry and Larsson et al. references and, therefore, are each in a condition for allowance. Furthermore, as dependent claims 40-41 further define patentably distinct claim 4, dependent claims 10-12 and 42-43 further define patentably distinct claim 9, and dependent claims 33-34 and 44-45 further define patentably distinct claim 32, Applicant submits that these dependent claims are also in a condition for allowance. Applicant, therefore, respectfully requests that the rejection of claims 4, 5, 9-12, 15, 18-20, 22, and 32-34 under 35 U.S.C. 103(a) be reconsidered and withdrawn, and that claims 4, 5, 9-12, 15, 18-20, 22, 32-34, and 40-45 be allowed.

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Title: PORTABLE WIRELESS DEVICE AND SOFTWARE FOR PRINTING BY REFERENCE**CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 4-5, 9-12, 15, 18-20, 22, 32-34, and 37-45 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Amendment and Response should be directed to either Nathan Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

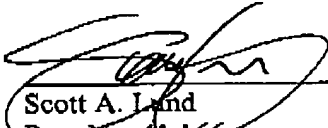
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Respectfully submitted,

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**CERTIFICATE UNDER 37 C.F.R. 1.8:** The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300 on this 28th day of September, 2006.

By   
\_\_\_\_\_  
Name: Scott A. Lund